

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 2-6, 8-18 and 20-33 were pending. By the present response, claims 14, 29 and 30 have been amended and claims 22, 23, 26, and 27 canceled. Thus, upon entry of the present response, claims 2-6, 8-18, 20, 21, 24, 25 and 28-33 remain pending and await further consideration on the merits. Claim 30 has been amended only to correct a spelling error.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims, Figure 6 and the specification, paragraph [0033].

CLAIM OBJECTIONS

At paragraph 2 of the Official Action, claim 14 was objected to for the noted informality. To address this objection, Applicants have amended claim 14 to depend from allowed independent claim 30. Withdrawal of the objection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claim 29 stands rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,492,315 to Maruyama et al. (hereafter "*Maruyama et al.*") on the grounds set forth in paragraph 4 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

Independent claim 29, the only claim at issue here, recites that a sheet-wise binding system comprises, *inter alia*, a trimmer configured to trim the edges of the sheets traveling through the sheet transport path to form a saw tooth edge feature and a controller programmed to control the sheet transport path and the trimmer to trim the edges of the

sheets at a varying depth according to a trim schedule to create the saw tooth edge feature. Claim 29 further recites that the saw tooth edge feature includes a plurality of document portions, each document portion including a plurality of trim sheets of varying trimmed depths to expose a surface of a first visible trimmed sheet of an adjacent document portion.

The *Maruyama et al.* patent discloses a sheet post-treatment apparatus having a tab trimmer 54 (see Figure 30). The tab trimmer provides multiple sheets with a tab as shown in Figure 31. As previously noted by the Applicants, the tab shown in Figure 31 is formed of similar depth in a direction perpendicular to an edge of the sheet on which the feature is to be formed and parallel to the transport direction of the sheet because the sheet is placed in a fixed relationship with regard to the retardable stopper 404. Also, these tab features appear in Figure 31 to be conventional divider tabs.

Comparing the disclosure in *Maruyama et al.* to the claim of the present application at issue here, Applicants respectfully assert that each and every feature of Applicants' independent claim 29 is not disclosed in the *Maruyama et al.* patent. Specifically, *Maruyama et al.* does not disclose trimming at varying depths and does not disclose a plurality of document portions where each document portion includes a plurality of trim sheets of varying trim depths to expose a surface of a first visible trimmed sheet of an adjacent document portion.

In light of at least these differences, Applicants respectfully submit that an anticipatory rejection is improper since the *Maruyama et al.* patent does not disclose the invention as claimed. Withdrawal of the above-noted rejection is therefore respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 32, 20, 21, 24, 25, and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Maruyama et al.* in view of U.S. Patent No. 4,819,021 to Doery (hereafter

"Doery") on the grounds set forth in paragraph 6 of the Official Action. Reconsideration of this rejection is respectfully requested.

The rejection based on disclosures in *Maruyama et al.* and *Doery* is improper because the combination of references does not teach or suggest all of the claim limitations. See MPEP §§2143. The Official Action correctly notes that *Maruyama et al.* "does not disclose punching the sheets at a variable depth in a direction perpendicular to an edge of the sheet." See paragraph 6 of the Official Action dated November 10, 2003. The Official Action then relies upon the disclosure in *Doery* alleging that *Doery* discloses "punching the sheets at a variable depth in a direction perpendicular to an edge of the sheet (see col. 7, lines 35-40) for the purpose of making longer (wider) tabs." See paragraph 6 of the Official Action. However, the disclosure in *Doery* does not disclose punching the sheets at a variable depth in a direction substantially perpendicular to an edge of the sheet.

The disclosure in *Doery* is directed to automatically providing tabbed sheets in the output of copy sheets of a copier with an integral, on-line, copy sheet tab cutting system. See col. 1, lines 4-7. The tab cutting system of *Doery* is illustrated in Figure 3. In Figure 3, a sheet 26 is shown inserted to a fixed depth. The fixed depth is limited by the fingers 34 which provide registration for stopping and aligning the copy sheet 26 at a tabbing registration position. See col. 5, lines 38-51. Once the sheet 26 is in the registered position, an upper tab cutting wheel 38 and a lower tab cutting wheel 29, both mounted for rotation, are advanced along rails 42 and 43 to provide a tab 28. Since the cutting wheels 38, 39 do not have any variation in depth, e.g., they do not move with respect to the depth of the sheet, these cutting wheels provide a tab with a fixed depth from the edge of the sheet on which the feature is formed. In other words, the disclosure in *Doery* positions a sheet 26 in a fixed position according to registration feature 34 and then cutting wheels 38 and 39 are translated to cut a fixed depth tab in the edge of the sheet.

Turning to the combination of *Maruyama et al.* and *Doery* asserted in the Official Action, Applicants respectfully note that neither *Maruyama et al.* nor *Doery* punch features at

a variable depth in a direction substantially perpendicular to an edge of the sheet on which the feature is to be formed as presently required by claim 32. Accordingly, the combination of *Maruyama et al.* and *Doery* is improper as the basis for an obviousness rejection because the combination of references does not teach or suggest all of the claim limitations. For at least this reason, the rejection should be withdrawn.

The remaining claims at issue here depend, either directly or indirectly, from claim 32 and are therefore distinguishable over the asserted combination in the Official Action for at least the same reason as discussed for the independent claim.

ALLOWABLE SUBJECT MATTER

Applicants note with appreciation the indication that claims 2-6, 8-13, 15-18, 30, and 31 contain allowable subject matter, as noted in paragraphs 9-12 of the Official Action, and that claim 33 would be allowable if rewritten in independent form. Applicants also respectfully assert that claim 14 is allowable as depending from allowed claim 30.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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